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10/586,609	07/19/2006	Akihiko Fujii	293709US0PCT	5969
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EXAMINER KING, FELICIA C				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/586,609

Applicant(s)

FUJII ET AL.

Examiner

FELICIA C. KING

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This Office Action is written in response to Applicant's Request for Reconsideration filed 9/23/09. Claims 1-17 are pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942) and Sosuke et al. (JP 6-315434 Translation).**

Regarding Claims 1 and 16: Slaga discloses a coffee composition having 0.6% chlorogenic acid [page.2, para 0023]] but does not explicitly disclose a coffee composition having less than .1 wt.% HHQ. However, Stelkens discloses a coffee composition where poisonous substances are removed by mixing and filtering with zinc chloride activated carbon [page 1, lines 12-26 and Page 1, lines 95-106]. Further, Sosuke discloses a coffee composition where "coffee poor ingredients" are removed by filtering ground coffee beans through activated carbon near 30 -100 A in size, coconut husk activated carbon near 10A in size, or zeolite (an absorbent mineral mix) around 1-5 A in size [0007, 0011, 0013, 0014].

At the time of the invention, it would have been obvious to one of ordinary skill in that art having the teachings of Slaga, Stelkens, and Sosuke before him or her to modify the coffee composition of Slaga to include a decreased level of HHQ because the treatment of coffee grounds with activated carbon at the desired particle size would have resulted in a coffee product having significantly reduced levels/removal of poisonous substances such as HHQ and to continue to reduce the levels of undesirable chemicals such as HHQ in coffee by using the activated carbon

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method, until the desired level/removal of the poisonous substance was obtained. Stelkens' removal of poisonous and bitter substances is in line with Slaga's art which seeks to provide for a more healthful coffee product which contains less toxic compounds [Slaga pg. 1, para 0018] and when used in combination with Sosuke as the desired particle size 30 -100 Å in size, coconut husk activated carbon near 10Å in size, or zeolite (an absorbent mineral mix) around 1-5 Å in size [0007, 0011, 0013, 0014], the coffee is treated using a very similar process as in the instant specification [See Application 10/586609 Example 7] and as such would have been obvious that a coffee composition having significantly reduced levels/removal of the poisonous substance HHQ would have been produced. Further, Sosuke's removal of "coffee poor ingredients" seeks to provide for a more palatable coffee beverage [0010]. Stelkens' and Sosuke's failure to specifically recite the removal of the named substance HHQ does not negate the fact that a toxic/poisonous/DNA damaging substance such a HHQ would have been removed by the activated carbon at the desired particle size.

Further regarding the particle size of the carbon, the sizes are substantially close to that of the instant claims, one of ordinary skill would have expected compositions that are in such close proportions to those in prior art to be prima facie obvious and to have same properties. *Titanium Metals Corp.*, 227 USPQ 773 (CAFC 1985).

Regarding Claim 2: Slaga, Stelkens, and Sosuke disclose a coffee composition treated in a similar manner as described above and as such, it would have been obvious that the coffee composition would have similar properties when analyzed by HPLC as the coffee composition in the instant claim.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942) and Sosuke et al. (JP 6-315434 Translation) and as evidenced by Suzuki et al. (EP 1186294).

Regarding Claim 3: Slaga, Stelkens, and Sosuke disclose as discussed above but do not disclose the composition as hypertension alleviating. However, Suzuki teaches that chlorogenic acid is known to alleviate hypertension [para 0013].

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke and Suzuki before him or her to incorporate chlorogenic acid as a hypertension alleviating agent because in addition to chlorogenic acid's medicinal benefits to the gastrointestinal tract [Slaga page 1, para 0007], it is known that food or beverages associated with hypertension such as coffee can be supplemented with chlorogenic acid to inhibit or reduce hypertensive effects [Suzuki para 0033].

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), and Kiefer (US 5,588,742) and as evidenced by Suzuki et al (EP 1186294).

Regarding Claims 4 and 5: Slaga, Stelkens, and Sosuke disclose the coffee composition as discussed above, Suzuki teaches as discussed above but they do not disclose labeling the composition. However, Kiefer discloses labeling products to indicate their nutritional content [col. 1, lines 51-67].

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke, Suzuki and Kiefer before him or her to label the coffee product described by the prior art because it enables the manufacturer to communicate to the

consumer ways in which the product is not only enjoyable as a beverage but how it is a healthier alternative to traditional coffee [Kiefer col. 4, lines 48-62, describing how labels impart information].

5. Claims 6, 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), and Schlichter (US 3,615,666).

Regarding Claims 6 and 17: Slaga, Stelkens, and Sosuke disclose a coffee composition treated in a similar manner as discussed above but do not disclose a soluble coffee composition. However, Schlichter discloses a soluble coffee composition [col. 1, lines 4-9].

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke, and Schlichter before him or her to modify the coffee composition to include a soluble coffee composition form because the consumer benefits from the ease of making a cup of coffee since making a drinkable beverage out of soluble coffee only requires the addition of hot water to dry coffee product in a cup/mug.

Regarding Claim 7: Slaga, Stelkens, Sosuke, and Schlichter disclose as discussed above and as such, it would have been obvious that the coffee composition would have similar properties when analyzed by HPLC as the coffee composition in the instant claim.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), and Schlichter (US 3,615,666), and as evidenced by Suzuki et al. (EP 1186294).

Regarding Claim 8: Slaga, Stelkens, Sosuke disclose the coffee composition as discussed above, Suzuki teaches that chlorogenic acid alleviates hypertension as discussed above and Schlichter teaches soluble coffee as disclosed above.

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke and Schlichter before him or her to modify the coffee composition to include a soluble coffee composition form because the consumer benefits from the ease of making a cup of coffee since making a drinkable beverage out of soluble coffee only requires the addition of hot water to dry coffee product in a cup/mug.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), Schlichter (US 3,615,666), and Kiefer (US 5,588,742) and as evidenced by Suzuki et al (EP 1186294).

Regarding Claims 9 and 10: Slaga, Stelkens, Sosuke disclose the coffee composition as discussed above, Suzuki teaches as discussed above, Schlichter discloses soluble coffee as discussed above, and Kiefer discloses labeling products to indicate their nutritional content [col. 1, lines 51-67].

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke and Kiefer before him or her to label the coffee product described by the prior art because it enables the manufacturer to communicate to the consumer ways in which the product is not only enjoyable as a beverage but how it is a healthier alternative to traditional coffee [Kiefer col. 4, lines 48-62, describing how labels impart information].

8. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), and Behrman (US 2,430,663).

Regarding Claims 11 and 15: Slaga, Stelkens, and Sosuke disclose the coffee composition as discussed above but does not disclose it as packaged. However, Behrman discloses a coffee composition in an oxygen impermeable package [col.1, lines 6-10, 14-17, 36-38].

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke and Behrman before him or her to modify the coffee composition of Stelkens to include an oxygen impermeable packaging mechanism because it maintains the qualities and flavors of coffee [Behrman col.1, lines 24-27].

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), Sosuke et al. (JP 6-315434 Translation), and Behrman (US 2,430,663) and as evidenced by Suzuki et al (EP 1186294).

Regarding Claim 12: Slaga, Stelkens, Sosuke disclose as discussed, Suzuki teaches that chlorogenic acid alleviates hypertension as discussed above and Behrman teaches a packaged coffee product as disclosed above.

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke, Behrman and Suzuki to package a coffee product in order to make it available to consumers and to maintain the qualities and flavors of coffee [Behrman col.1, lines 24-27].

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slaga et al. (US 2004/0005398) in view of Stelkens (GB 354,942), and Behrman (US 2,430,663), and Kiefer (US 5,588,742) and as evidenced by Suzuki et al (EP 1186294).

Regarding Claims 13 and 14: Slaga, Stelkens, Sosuke disclose a coffee product as discussed above, Suzuki discloses chlorogenic acid's antihypertensive effects as discussed above, Behrman

discloses a packaged product as discussed above, and Kiefer discloses labeling the product as discussed above.

At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Slaga, Stelkens, Sosuke, Suzuki, Behrman, and Kiefer before him or her to include on a packaged beverage where the beverage has antihypertensive properties to place a label on the package to indicate that it has hypertensive properties in order to communicate this feature to consumers.

Response to Arguments

Applicants' arguments with respect to claims 1-17 in the Request for Reconsideration filed 9/23/09 have been fully considered but they are not persuasive.

11. On page 3 of Applicants' Request for Reconsideration, Examiner acknowledges Applicants' reproduction of experiments in view of the Sosuke disclosure upon which Applicants bases the deficiency of the prior art's lack of indicating the removal of HHQ. However, it appears that the applicant has taken the disclosure of Sosuke alone in order to show the extraction of HHQ. However, Slaga, Stelkens and Sosuke were used in combination. Examiner is unsure as to why an extraction time of 3 minutes was used in Applicants' experiment; especially where the disclosure in Stelkens has a 5 minute exposure time and Sosuke was incorporated to show the type of filtering material. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, as disclosed in Stelkens the coffee composition obtained by the extraction process is further diluted until it reaches a drinkable concentration [pg. 2, lines 1-7]. Referring back to the

Declaration submitted by Applicant on 4/24/09, it was determined that under Stelkens the chlorogenic acid content would have been .46549% and the HHQ would have been .0012%. As disclosed in Stelkens, the coffee was initially extracted with 100ml to 200ml of water and then diluted up to 1L with water to produce a drinkable coffee composition. The instant claims recite a coffee composition containing .01% to 1% of chlorogenic acids and less than .1% HHQ. Based upon the experiments conducted by Applicants, it would have been obvious that by further diluting the extracted coffee at points up to 1 L, that the amounts of chlorogenic acid and HHQ would have been diluted to meet the limitations of the claims.

12. Further if appears from applicant's specification that time and dilution is a factor in attaining desirable chlorogenic acid and HHQ levels. In the Specification, pages 39-41 including Table 5, applicants allow the coffee to undergo extraction for 30 minutes and further allow for the extracted coffee to be diluted to balance. Variables such as time and dilution are well known in the art and it would have been obvious to one having ordinary skill to lengthen extraction time to extract more of a substance and further that by diluting a substance with water thereby increasing the volume, that substances contained in the product would have been reduced relative to the overall composition.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FELICIA C. KING whose telephone number is (571)270-3733. The examiner can normally be reached on Mon- Thu 7:30 a.m.- 5:00 p.m.; Fri 7:30 a.m. - 4:00 p.m. alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. K. /
Examiner, Art Unit 1794

/Jennifer McNeil/
Supervisory Patent Examiner, Art Unit 1794